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EXAMINER

JONES, SCOTT E

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3714

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/709,574
Filing Date: November 13, 2000
Appellant(s): BAE ET AL.

MAILED
FEB 09 2007
Group 3700

John C. Eisenhart
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 13, 2006 appealing from the Office
action mailed September 27, 2005

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,654,746	McMullan, Jr. et al.	8-1977
5,935,004	Tarr et al.	8-1999
6,267,672	Vance	7-2001

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 14, 16, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by McMullan, Jr. et al., U.S. Patent No. 5,654,746. McMullan discloses a game service system including a game service-transmitting device. The transmitting device comprises a multiplexer configured to convert image information and audio information of a broadcast signal, a game program, and game-related information into a transport stream. A transmitting unit is configured to channel-code, modulate, amplify and transmit the transport stream (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; Fig. 1 & 3). A game receiving device comprises a tuning unit configured to receive the image and audio information of the broadcast signal, a game program ordered by a user, and game-related information, and to select either the image and audio information corresponding to a broadcast channel desired by the user, or the game program ordered by the user. A common game interface module is configured to demodulate a selected game program and game-related information, to error correct the demodulated information, to download the game program and store the game program in a game memory portion of the common game interface unit for access by a user when desired, and to process the game-related information (See McMullan col. 3 lines 47-58;

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col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46

Fig. 1 & 3) [claims 1, 3]. A game service transmitting device and system comprises a multiplexer configured to convert image and audio information of a broadcast signal, a game program, and game-related information by packet unit on a time basis into a transport stream. A transmitting unit is configured to channel-code the transport stream and to modulate, amplify, and transmit the transport stream to a receiving unit when requested by a user (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46 Fig. 1 & 3) [claims 2, 3]. The game server is configured to receive a game-ordering signal indicating a game desired by a user and to provide the selected game program and game-related information (See McMullan col. 14 lines 25-67) [claim 4]. The game service receiving device comprises a tuning unit configured to receive image and audio information of a broadcast signal, a game program ordered by a user, and game-related information and configured to select either the image and audio information corresponding to a channel desired by a user or a game program ordered by the user. A common game interface module is configured to demodulate a selected game program and game-related information, to error correct, download and process the demodulated game program and game-related information and to store the game program for access by a user when desired (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46 Fig. 1 & 3) [claim 5]. A downloader is configured to download the game program ordered by the user using the game-related information (See McMullan col. 14 lines 25-67) [claim 6]. The common game interface module includes a game memory configured to store the downloaded game program and a CPU configured to execute the stored game program (See McMullan col. 11

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lines 63-67; col. 12 lines 1-6) [claim 7]. The CPU is configured to execute the game program upon receipt of a controlling command input through a user interface (See McMullan col. 14 lines 25-67) [claim 8]. McMullan further discloses a game service transmitting method comprising converting image and audio information of a broadcast signal, a game program, and game-related information by packet unit on a time basis into a transport stream. The transport stream is coded, amplified and modulated over a certain channel (See McMullan col. 4 lines 16-39; col. 5 lines 17-40) [claim 14]. In the game service receiving method, a game list is extracted comprising game-related information from a transport stream that includes time basis multiplexed packet units of image and audio information of a broadcast signal, a listing of game programs and game-related information. A game program is downloaded by a user according to the game-related information and the program is stored in a game memory portion of a receiving device and the game is executed (See McMullan col. 14 lines 25-67) [claim 16]. Game-related information comprises a packet identifier (PID) configured to identify a packet of a game program ordered by a user and a game list (See McMullan col. 12 lines 30-35) [claim 18]. A broadcast and receiving device comprises a downloader configured to receive a transport stream having time basis multiplexed packet units of image and audio information of a broadcast signal of a channel, a game program, and game-related information, and to download a game program ordered by a user using the game-related information encoded with the image and audio information of the broadcast signal. Game memory is configured to store the downloaded game program for access by a user when desired. A CPU is configured to execute the stored game program in response to a user request (See McMullan col. 3 lines 49-58; col. 4 lines 30-35; col. 5 lines 17-46; col. 14 lines 25-67) [claim 20].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McMullan et al., in view of Tarr et al., U.S. Patent No. 5,935,004. McMullan discloses a game service receiving device comprising a processor configured to receive an input from a user interface, and to output either a first control signal to select a broadcast signal of a channel desired by a user or a second control signal to order a game desired by the user (See McMullan col. 1 lines 65-67; col. 2 lines 1-62; col. 3 lines 36-59; Fig. 1). A common game interface module is configured to receive the first control signal and to demodulate a broadcast signal of a channel selected by the user, a game program and game related information, wherein the common game interface module is also configured to error correct download, store, and process the demodulated game-related information so as to allow a user to view the selected channel or execute the selected game (See McMullan col. 3 lines 49-58; col. 4 lines 8-39; col. 5 lines 17-46; col. 6 lines 43-54; col. 9 lines 2-5 [claim 9]). A common interface host is configured to provide a resource for processing the game program and the game-related information (See McMullan Fig. 1) [claim 10]. The common interface module includes a downloader configured to download the game program ordered by the user using the game-related information (See McMullan col. 10 lines 51-54) [claim 11]. The common game interface module includes a game memory configured to store the downloaded game program and a CPU configured to execute the stored

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game program (See McMullan col. 11 lines 63-67; col. 12 lines 1-6) [claim 12]. The CPU is configured to execute the game program upon receipt of a controlling command input through a user interface (See McMullan col. 14 lines 25-47) [claim 13]. McMullan lacks in disclosing a modem.

Tarr et al. teaches of using a modem configured to receive a control signal to order a game desired by the user and outputs a corresponding game ordering signal (See Tarr col. 3 lines 22-27; col. 4 lines 60-62) [claim 9]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cable modem in the invention of McMullan so as to receive signals from different locations thereby being able to provide the users with more programming choices.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan et al., in view of Vance, U.S. Patent No. 6,267,672 B1. McMullan lacks in disclosing adding a new game to the list. Vance teaches of adding a new game program and game-related information to a previously established game list (See Vance col. 2 lines 58-63) [claim 15]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to install new games desired by a user. By installing new games desired by a user, the system is giving its customers the games in which they want to play. Therefore, if the games the customers want are implemented into the system, these individuals will remain customers. Furthermore, the level of excitement in the games and system remains high, which increases the number of customers.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan, Jr. et al., in view of Okamoto, U.S. Patent No. 5,489,103. McMullan lacks in

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disclosing having a user request a game when the game is not included in the extracted game list. Okamoto teaches that an extracted game list is displayed to a user on a screen (See Okamoto Fig. 5). The user requests a game program from a transmitting party (See Okamoto Fig. 6). It is clear that the user may request a game program from the transmitting party when the game program selected is not included in the displayed game list. In the system of Okamoto, a user enters the number of the game they wish to play, it is clear that a player may enter an invalid number [claims 17 & 19]. For example, if there are only games 1-5, the player can still enter the number 9 and an error may be generated or no game is provided. Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow users in the system of McMullan to select games that are not included on a displayed list by going to a channel that is not on the list. This is similar to a user selecting a television channel on their TV set that they do not get image information. Nothing stops a user from attempting to get a game that is not available. It is a matter of curiosity to select game or channels that are not available and see whether or not they are truly not available.

(10) Response to Argument

Appellant alleges the Examiner has disregarded claim limitations because the Examiner has indicated certain claim limitations are directed to an intended use. Although the Examiner has made this observation, the Examiner has additionally rejected the certain claim limitations based on the prior art. MPEP 2173.05(g)-Functional Limitations, states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional

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language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In Innova /Pure Water Inc. v. Safari Water Filtration Sys. Inc., 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." "In the absence of modifiers, general descriptive terms are typically construed as having their full meaning." Id. at 1118, 72 USPQ2d at 1006. In the patent claim at issue, "subject to any clear and unmistakable disavowal of claim scope, the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." Id. at 1120, 72 USPQ2d at 1008.

Additionally, In response to applicant's argument that the Examiner has disregarded claim limitations because the Examiner has indicated certain claim limitations are directed to an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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A. Claims 1-8, 14, 16, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by McMullan, Jr. et al., U.S. Patent No. 5,654,746.

Appellant discusses what McMullan allegedly discloses. Appellant alleges McMullan does not disclose the ability to select the image and audio information corresponding to a broadcast channel desired by a user. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46 Fig. 1 & 3) [claims 1, 3].

Appellant alleges McMullan fails to disclose or suggest a game service receiving device comprising a tuning unit configured to receive the image and audio information broadcast signal, a game program ordered by a user, and a game related information, and to select either the image and audio information corresponding to a broadcast channel desired by the user, or the game program ordered by a user, as recited in claims 1 and 5. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46 Fig. 1 & 3) [claims 1, 3].

Appellant alleges McMullan fails to disclose or suggest a multiplexer configured to convert image and audio information of a broadcast signal, a game program, and game related information by a packet unit on a time basis into a transport stream, as recited in claims 2 and 3. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 3 lines 47-58; col. 4 lines 32-35; col. 5 lines 33-40; col. 6 lines 43-47; col. 7 lines 33-36; col. 14 lines 25-46 Fig. 1 & 3) [claims 2, 3].

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Appellant alleges McMullan fails to disclose or suggest converting image and audio information of a broadcast signal, a game program, and game-related information by packet unit on a time basis into a transport stream as recited in claim 14. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 4 lines 16-39; col. 5 lines 17-40) [claim 14].

Appellant alleges McMullan fails to disclose or suggest extracting a game list comprising game-related information from a transport stream that includes time basis multiplexed packet units of image and audio information of a broadcast signal, a listing of game programs, and game-related information as recited in claim 16. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 14 lines 25-67) [claim 16].

Appellant alleges McMullan fails to disclose or suggest a broadcast and game receiving device, comprising a downloader configured to receive a transport stream having time basis multiplexed packet units of image and audio information of a broadcast signal of a channel, a game program, and game related information, and to download a game program ordered by a user using the game related information encoded with the image and audio information of the broadcast signal recited in claim 20. The Examiner respectfully disagrees and asserts the feature is disclosed in McMullan (See McMullan col. 3 lines 49-58; col. 4 lines 30-35; col. 5 lines 17-46; col. 14 lines 25-67) [claim 20].

For the above reasons, it is believed that the rejection to claims 1-8, 14, 16, 18 and 20 under 35 U.S.C. 102(b) as being anticipated by McMullan, Jr. et al., U.S. Patent No. 5,654,746 should be sustained.

B. 35 U.S.C. § 103(a)

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1. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan et al., in view of Tarr et al., U.S. Patent No. 5,935,004.

Appellant alleges McMullan fails to disclose or suggest a processor configured to receive an input from a user interface, and to output either a first control signal to select a broadcast signal of a channel desired by a user, or a second control signal to order a game desired by a user as recited in claim 9. Furthermore, Appellant alleges McMullan fails to disclose or suggest a common game interface module configured to receive the first control signal and to demodulate a broadcast signal of a channel selected by user, a game program, and game-related information as recited in claim 9. Appellant alleges Tarr fails to overcome McMullan's deficiencies. The Examiner respectfully disagrees as discussed in Item A above, as well as, in the Final Rejection above. Accordingly, it is believed that the rejection to claims 9-13 under 35 U.S.C. 103(a) as being unpatentable over McMullan et al., in view of Tarr et al., U.S. Patent No. 5,935,004 should be sustained.

2. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan et al., in view of Vance, U.S. Patent No. 6,267,672 B1.

Appellant alleges McMullan fails to disclose or suggest all of the features of claim 14 and that Vance does not remedy the deficiencies. The Examiner respectfully disagrees for the same reasons discussed above in Item A. Thus, it is believed that the rejection to claim 15 under 35 U.S.C. 103(a) as being unpatentable over McMullan et al., in view of Vance, U.S. Patent No. 6,267,672 B1 should be sustained.

3. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan, Jr. et al., in view of Okamoto, U.S. Patent No. 5,489,103.

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Appellant alleges McMullan fails to disclose or suggest all of the features of claim 16 and that Okamoto does not remedy the deficiencies. The Examiner respectfully disagrees for the same reasons discussed above in Item A. Thus, it is believed that the rejection to claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullan, Jr. et al., in view of Okamoto, U.S. Patent No. 5,489,103 should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

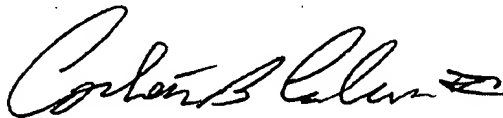
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Art Unit 3714, Primary Examiner



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Art Unit: 3714

A handwritten signature in black ink, appearing to read 'B. Olszewski', followed by the date '2/5/07'.

Bob Olszewski,

Art Unit 3714, SPE